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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,108	09/19/2003	Steven A. Root	8379.006	8548

30589 7590 03/25/2004

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EXAMINER

MCELHENY JR, DONALD E

ART UNIT	PAPER NUMBER
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2857

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,108

Applicant(s)

ROOT ET AL.

Examiner

Donald E. McElheny, Jr.

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09-19-03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9-19-03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,505,123.

The conflicting claims are identical with the exception of minor changes of deleting some limitations to broaden claims or alternative phrasing of similar claim features. For example, such as deleting terms relating to "weather" from the patented claims to broaden them and create the present application's claims; or the rephrasing of the user profile user-defined parameters directed to the identical supported disclosed features. It would have been obvious to one of ordinary skill in the art that one could delete claim limitations of patented claims, or use different language and phrases to describe the same basis claim features, and not depart from the invention of the patent. Such variations could have been claimed during the prosecution of the patent.

An example of the potential mapping of the claims between this application and the patent is as follows. Instant application independent claims 1, 10, 16, 22 and 31 map respectively to claims 1, 7, 13, 19 and 25 of the patent. Instant dependent claims 2-6 map to patent claims 2-6. Instant dependent claims 11-15 map to claims 8-12 of the patent. Remaining dependent claims of the instant application correspond similarly to dependent claims of the patent, or are directed (e.g. instant claims 7-9) to variations that would not have involved the concept of invention as they were to notoriously well known alternative data formats in communications networks for transfer of such type of data as the instant claims and patent are directed.

Since the claims are drawn to broader subject matter and well known obvious variants than those claims already granted to an issued patent it would have been an obvious design choice to merely delete or alter (broaden) elements from the patented combination of elements, or to use well known equivalent alternatives or add other obvious limitations to claims that do not involve the concept of invention.

4. Claims 1-38 of this application conflict with the claims of Application No. 10/322,187, and also Application No. 10/355,971. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

5. Claims 1-38 are provisionally rejected under the judicially created doctrine of double patenting over claims 1+ of copending Application No. 10/322,187 and claims 1+ of Application No. 10/355,971. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter. Differences amount to either simple deletion or broadening of a claim feature between corresponding independent and dependent claims respectively between applications, and/or rephrasing of commonly claimed features.

For example, claims 1-6 of the instant application correspond with claims 1-6 of the related applications.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application.

Applicants' attention is directed to MPEP 804.02, section IV, regarding conflict between plural applications and/or patents by the same inventors or assignee. A single Terminal Disclaimer may be filed, wherein all the conflicting double patenting references are disclaimed therein.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwoegler (6,590,529).

Note the filing date of this patent is that of its provisional application, which contains full support for the subject matter of the patented application and which is the basis in this prior art rejection.

Basically, Schwoegler teaches tracking a user and their location in real time to compare with monitored events and alert the user (e.g. of approaching or current weather) according to the user's prescribed requested or stored (database) criteria as the event relates to the user and their location. The user may set a variety of parameters relating to such events, including as explicitly set in an example of user preferred sensitivity level based upon tracking of the weather over plural cells and the weather forecast being analyzed down to the exact current real time location of the

user. Numerous options in types of networking systems and communications devices are set forth and would inherently, if not explicitly, include any of those claimed.

While this patent does not use the identical terminology as applicants for all claimed features, or does not discuss in depth and details of disclosure for certain claim features, such features are nevertheless met by full equivalents or inherent within the systems taught used by this reference and would have been obvious to one of ordinary skill in the art as differences that do not the concept of invention. Examples are given below.

Differences in terminology such as relating to “user identifier code identifying a communicator device” would be within the inherent and necessary unique address identification codes used to address and communicate to and from each type of the various types of communication devices taught by Schwoegler, such as these communication networks and servers were well known to make use of. Such well known networks and servers would also inherently maintain the necessary stored information in databases (claimed “database”) for the various related user communication devices, system data operations, and their user’s requested and preferred operational control information. The term “spatial locations” are met by the explicit teachings of tracking the real time location of users by GPS (Global Positioning System) readings, as well as the users’ preferences and predetermined locations they have interest in because of possible future events dictating their movement to that location. The term “spatial range identifier” is met by any of the various alternatives taught that track the user’s position and their preference or requested desire for

information within a specified location resolution of an event, such as weather, (see column 10, lines 6+), or as dictated by the type of user service (e.g. weather or storms) being used such as individual person versus marine or aircraft vehicles and activities which inherently involve different spatial ranges of interest per the user's preferences, or a user's customized parameters preferences set by categories of events, alarm thresholds, and distances from user (see column 10, lines 41+). The column 10 example taught allows a user to have his weather alert criteria set for various types of weather, various levels of alert levels, various distance ranges of the selected type of weather event, and also include predicted and forecast alerts affecting those user selected regions and preferences. The term "vendors" (e.g. claims 37, 38) is inherently met by the teachings of the various types of networks such as pagers, cellular telephone systems, Internet service providers, etc., which provide (i.e. vend) such services to their customers for a fee.

9. Other prior art cited of record also teaches the claimed invention in whole or part for reasons similarly given above for Schwoegler. The critical difference in the claim relative to the prior art of "spatial range identifier" is seen to have its concept met by a variety of references already of record where they monitor the user's location relative to whatever the event being monitored to alert the user at their current real time location. The combination of such with any of the other references of record teaching a variety of alert notification systems that do not necessarily keep the user's preferences at the central database and instead internal at the user's personal communication device would have been obvious to combine as it was well known to eliminate unnecessary

bandwidth and burden on the central computer system and let the remote user's device do that processing and pick out which data it needs. Lemelson et al. (6,028,514), Baron, Sr. et al. (6,018,699), Kelly et al. (6,498,987), Clark et al. (6,611,687), Foust (6,240,369), Burfeind et al. (6,360,172), Murray (6,040,781) and Cannon et al. (5,974,447) are the most relevant in terms of teaching the communications information service system and its features relating to user alert of events at their locations.

10. If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald McElheny Jr., whose telephone number is (571) 272-2218.

Art Unit: 2857

Fax transmissions may be directed to (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Marc Hoff, can be reached at (571) 272-2216.


DONALD E. McELHENY, JR.
PRIMARY EXAMINER